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with respect to [applicant's] disclosed [aspect]. Because the evidence showed that a certain [aspect] was a 'hypothetical structure,' it was not persuasive of obviousness." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986).

Here, Yang repeatedly indicated his memo "does not specify an Internet standard of any kind" (page 1, "Status of this Memo"). More persuasively, Yang states, "[s]uch a phone service through the Internet **will be a major step**" (page 1, Abstract, emphasis added). Additionally, in Yang's "Recommendation," he states, "[I]f there is enough interest . . . IAB may need to consider forming a special task force . . . to **further look into the matter.**" (page 5, "Recommendation," emphasis added). Furthermore, Yang states, "telephone service on the Internet **will be a major step . . . and a great challenge to the future development of the Internet infrastructure and protocol architecture**" (page 2, Introduction, last paragraph, emphasis added). Lastly, with respect to the "directory servers" discussed in Yang, Yang acknowledges that "the function of a Directory Server for the INETPhone may require another open specification."

This, it is clear that Yang "proposes" a wish list for future developments without any enabling detail as to how such developments can be realized. This does not suffice to provide the requisite teaching or suggestion to render the present invention obvious. "Objective evidence or secondary considerations such as unexpected results, commercial success, **long-felt need, failure of others**, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present." MPEP § 2141, rev. July 1998, p. 2100-103, emphasis added.

Instead of rendering the present invention obvious, the passages in Yang demonstrate that the present invention addresses a solution to the needs and failures plaguing the prior art. This is

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a far cry from an actual teaching or suggestion of , for example, “a method for selecting a gateway proximal to a network access point that satisfies a predefined call service on a hybrid network” as recited in claim 19. In fact, it shows that Yang recognized the need for such a system in the future, a classic indication of nonobviousness under *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). Thus, the present invention is at least picking up where the prior art teachings end by creating a solution to the problems plaguing the prior art.

Accordingly, a *prima facie* case of obviousness has not been properly established, and it is respectfully urged that the rejection of claims 19-30 be reconsidered and withdrawn.

Furthermore, even if *arguendo*, Yang was enabling, the Office has still not made a *prima facie* case of obviousness for the following reasons.

For example, claim 19 recites, *inter alia*, “transmitting a query including a type of call service to the directory service to obtain a plurality of gateways between the packet switched network and a circuit switched network that match the predefined call service criteria.” The Office Action states that Yang discloses, “[w]hen the first server which generates a query message to a directory server to obtain at least on[e] of a plurality of gateways.” Applicant notes that the Office Action has, at a minimum, not provided a teaching or suggestion of the above limitation. The Office has failed to provide a teaching or suggestion in Yang of “transmitting a query . . . to the directory service to obtain a plurality of gateways” as recited in claim 19. The Office has also failed to provide a teaching or suggestion in Kubler of “transmitting a query . . . to the directory service to obtain a plurality of gateways” as recited in claim 19.

The Office correctly acknowledges that Yang does not disclose querying each of the plurality of gateways and provides Kubler to allegedly teach “a method of receiving a call type service; and querying each of the pluralities of gateways to determine a network topology “low

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cost routing”; ranking the plurality of gateways according to the network topology “low cost routing” and the service call criteria.” Applicant respectfully disagrees. As stated in Col. 94, lines 43-48 of Kubler, “[u]pon receiving a call setup request packet as indicated by the event block 5903, the access device first attempts to find a lowest cost external routing pathway for the call. At a block 5917, the access device consults its routing table to identify the lowest cost direct or upstream access to an available outgoing telephone line.” Clearly, Kubler does not teach or suggest at least “transmitting a query . . . to the directory service to obtain a plurality of gateways” and “querying each of the plurality of gateways to determine a network topology to service the call” since Kubler instead, refers to a “routing table.” Since Kubler teaches away from the recitations in claim 19, it cannot provide the necessary suggestion or teachings needed by the deficiencies of Yang.

With respect to independent claim 25, neither Yang nor Kubler, taken alone or in combination, teach or suggest a call router with logic for, *inter alia*, “querying each of the plurality of gateways to determine a network topology to service the call.” The Office correctly acknowledges that Yang does not disclose querying each of the plurality of gateways and provides Kubler to allegedly teach “a method of receiving a call type service; and querying each of the pluralities of gateways to determine a network topology “low cost routing”; ranking the plurality of gateways according to the network topology “low cost routing” and the service call criteria.” Applicant respectfully disagrees. As stated in Col. 94, lines 43-48 of Kubler, “[u]pon receiving a call setup request packet as indicated by the event block 5903, the access device first attempts to find a lowest cost external routing pathway for the call. At a block 5917, the access device consults its routing table to identify the lowest cost direct or upstream access to an available outgoing telephone line.” Clearly, Kubler does not teach or suggest at least a call router with logic for, *inter alia*, “querying each of the plurality of gateways to determine a

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network topology to service the call" since Kubler instead, refers to a "routing table." Since Kubler teaches away from the recitations in claim 25, it cannot provide the necessary suggestion or teachings needed by the deficiencies of Yang.

Since a *prima facie* case of obviousness has not been made, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 19 and 25 under 35 U.S.C. § 103(a).

The dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. Moreover, these claims recite additional subject matter which is not suggested by the cited documents taken either alone or in combination.

With respect to the Examiner's comments on page 5 of the Advisory Action, that "the teaching of Yang, Kubler and a well known TCP/IP diagnostic utility perform the claimed invention," Applicant respectfully disagrees. Furthermore, the Office has not provided a proper motivation to use ping, trace route, packet latency, or packet echo in the hypothetical combination of Yang and Kubler. The Office correctly acknowledges that Yang does not teach querying each of the plurality of gateways to determine a network topology. As stated with respect to the independent claims, Kubler also does not teach nor suggest querying each of the plurality of gateways to determine a network topology since it, in contrast, accesses a single routing table. Therefore, a *prima facie* case of obviousness has not been made for the dependent claims since in order to use ping, trace route, packet latency, or packet echo, one would have to modify Yang and Kubler in a manner contrary to the intended operation of their systems.

Furthermore, the "evidence" cited by the Office in response to Applicant's request in the Amendment filed May 22, 2000, provides only evidence of diagnostic systems and not a motivation to use such diagnostic systems to analyze the topology of a hybrid network. The Office states in the Advisory Action that "Yang and Kubler disclose packets being transmitted

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via Internet by using a well known in the art and wisely using in the public as Internet Protocol such as TCP/IP, UDP which includes Ping, trace route, packet echo, and packet latency command." The mere fact that Yang and Kubler transmit packets on the Internet is not sufficient to provide motivation to use ping, trace route, packet latency, or packet echo in order to analyze the network topology as recited in the dependent claims, especially since neither Yang nor Kubler provide any teaching or suggestion of using ping, trace route, packet latency, or packet echo in combination with the other elements and steps recited in the independent claims.

For at least the above-identified reasons, Applicant respectfully requests that the rejections of the claims under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

All objections and rejections raised in the Office Action having been addresses, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited.

In the event there are any issues left unresolved by this Amendment, Examiner is requested to contact the undersigned attorney to schedule a personal interview prior to issuance of another Office Action. The undersigned attorney can be reached at (202) 736-6522.

Respectfully submitted,



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Dated: July 24, 2000

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